

REMARKS

This is a Response filed under 37 C.F.R. § 1.111 to the Office Action mailed on June 25, 2008 in the above-referenced patent application. By this Response, we have amended claims 1-5 and 7-11 without prejudice or disclaimer and added new claims 12-20. Claims 1-5 and 7-20 (3 independent claims and sixteen dependent claims) remain pending after entry of the amendments. Support for the new claims may be found in the Specification as originally filed, for example at paragraphs 0021 through 0027.

Drawings

A replacement sheet for FIG. 1 is attached to add the number for the "rear panel" as required by the examiner. An annotated marked-up drawing sheet is also attached for the convenience of the examiner.

Specification

Paragraphs 0026 and 0027 have been amended to correct inadvertent typographical errors in the application as filed.

Prior Art Rejections

The Office Action requests clarification of the differences between our claimed invention and the combined teachings of US Patent 3,016,261 ("Tatters") and US Patent 5,775,028 ("Lambert") and US Patent 3,782,036 ("Clark"). None of these patents teach a hinge device as claimed, either separately or in combination. Specifically none teach a hinge device with "a coupling mechanism module separate from the housing module that is configured for insertion into said open side of said housing module". Tatters, the primary reference, has a housing module that is an integral part with the coupling mechanism, and which therefore could not be separate from the coupling mechanism as required by the amended claim 1. The Office Action does not describe the other references as having this feature, as the other references do not in fact describe this feature.

Indeed, the Office Action readily admits that the Tatters reference does not describe *a coupling mechanism separate from the housing module*, instead relying upon forty-year-old case law for the proposition that “constructing a formerly integral structure in various elements involves only routine skill in the art”. The exact case cited by the Office Action, however, has been expressly found by the Board of Patent Appeals and Interferences to lack support for this position. In discussing the Nerwin v. Erlichman case cited in the Office Action, the BPAI stated:

“The examiner’s reliance on and citation of Nerwin v. Erlichman, 168 USPQ 177, 179 (Bd.Pat.Int. 1969), which according to the examiner held that “constructing a formerly integral structure in various elements involves only routine skill in the art,” appears to us to be misplaced. **We find no such “holding” in Nerwin v. Erlichman.** The only statement in that case which we think may be referred to by the examiner is one which indicates that “[t]he mere fact that a given structure is integral does not preclude its consisting of various elements.” This statement, in our view, is a construction of the term “integral,” and **does not appear to stand for the proposition the examiner now urges.**”¹

Although the opinion quoted above is non-precedential, the Board specifically reviewed the same case cited for the exact same proposition and reversed the rejection that was based on this proposition. The same result would be expected under the facts of the present application. Because the Office Action erroneously relies upon Nerwin v. Erlichman for a legal conclusion that is not supported by the case, the rejections of our claims cannot stand.

¹ Ex parte GRUDEN et al.(PBAI Appeal No. 97-1147 Application 08/349,087) (non-precedential) (emphasis added).

Further, producing the hinge in two separate modules is non-obvious because this feature provides unexpected results, as discussed in the specification. Specifically, as discussed in paragraph 0003, by producing the hinge in two separate parts, a pantographic hinge can be connected to the door of a vehicle and to the body of a vehicle, and the door can be painted at the same time as the body of the vehicle without damaging the parts of the pantographic hinge.

The Office Action states that the hinge of Tatters ('261) can be combined with the method of manufacturing a vehicle body according to Clark ('036) to produce the claimed invention. If the teachings of these patents were combined they would produce a vehicle with the door of Clark and the hinge of Tatters, but they would not produce the claimed invention as amended, as neither of the references teach an arm having a housing module separate from a coupling mechanism according to claims 10 and 11.

As a result, the claimed invention is not obvious, and no single reference, nor any combination of references, is able to disclose each and every element of our independent claims 1, 9 and 10. The various dependent claims contain additional patentable features, but a discussion of these is cumulative to the analysis provided above and therefore unnecessary at this time. Nevertheless, we reserve the right to independently assert the patentability of any feature of any claim at a later date, including in an appeal.

Conclusion

In view of Applicant's amendments and remarks, it is respectfully submitted that the Examiner's rejections have been overcome. Accordingly, Applicants respectfully submit that the application, as amended, is now in condition for allowance, and such allowance is therefore earnestly requested. Should the Examiner have any questions or wish to further discuss this

application, Applicants request that the Examiner contact the Applicants' attorneys at the below-listed telephone number

No official fee is believed to be due in connection with this Response. If, however, any time extension or fee is required to consider this response or otherwise prevent abandonment of this application, please consider this as a request for an extension of time and as authorization to charge Deposit Account No. 50-2091 for any fee that may be due.

Respectfully submitted,
INGRASSIA FISHER & LORENZ, P.C.

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Annotated Marked-up Drawing

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Examiner:

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Fig. 1 (Amended)

